IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Hiroshi NAKATANI**   Art Unit: **1795**

Application Number: **10/570,151**   Examiner: **Peter L. Vajda**

Filed: **March 1, 2006**   Confirmation Number: **8047**

For: **TONER**

Attorney Docket Number: **071850**
Customer Number: **38834**

PRE-APPEAL BRIEF

Mail Stop: AF   May 17, 2010
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request is filed concurrent with a Notice of Appeal in compliance with 37 C.F.R.

§41.31. Applicant requests review of the final rejection in the above-identified application. No

amendments are being filed with this request.

REMARKS

Claims 1 and 3-17 are currently pending.

Rejection of the February 4, 2010 Office Action

Claims 1 and 3-17 are rejected under 35 U.S.C. §112, first paragraph, on the basis that

the specification does not properly provide for the silica particles being nonconductive nor are

any conductivity or resistance values for the silica fine particles taught.   Specifically, the

rejection of February 4, 2010 maintains that the submission of a known resistivity of a silica

material is not sufficient to show that all silica particles are nonconductive.

In the August 18, 2009 Office Action, the Examiner had requested a Declaration demonstrating that the conductivity of silica is known in the art. Applicants submitted the Declaration as requested. The rejection now asserts that the Declaration is insufficient on the basis that there is no manner whereby a skilled artisan would know that the silica particle referred to in the specification is the same as the silica particle set forth in the Declaration. Specifically, the rejection states that it has not been shown that the silica particles recited in the specification have the resistivity of the silica particle of the Declaration and applicants should have shown conductivity/resistivity measurements involving the silica materials used in the inventive embodiments.

Additionally, the rejection notes an apparent discrepancy between the translation of the Japanese reference having a resistivity of $1x10^{21}$ Ωm, whereas the declaration at paragraph 6.(B) recites that the resistivity is $1x10^{13}$ Ωm.

After noting the disclosures of the cited secondary reference, the rejection then asserts that the copy of the reference is not legible with regard to the resistivity value being cited.

In response to the argument that one skilled in the art would have recognized that the silica particles were nonconductive because resistive properties of the toner are detailed in the specification, the rejection asserts, similar to the general remarks noted above, that the specification does not specifically mention resistivity or conductivity of the silica particles. Further the rejection holds that the discussion of conductivity properties for the conductive inorganic fine particles does not speak to the conductivity of the silica particles.

Applicable Law

Under U.S. patent law as restated at M.P.E.P §2163.07(a): "By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, <u>even though it says nothing explicit concerning it</u>. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971)." (Emphasis added).

Argument of Clear Error

"Silica" is a commonly used term for a non-conductive silicon oxide, as noted in the cited secondary reference attached to the Declaration submitted. It is well known and understood that all silica is non-conductive unless some other material which has conductivity such as a metal is included therewith. As the specification does not provide for the inclusion of any other material which could render the silica particles conductive, it is unarguable that the silica is anything but non-conductive. Namely, silica has a known inherent property and applicants have merely stated that property.

Further, applicants respectfully note that there is no discrepancy in resistivity between the Declaration and the reference submitted in the last response. Within the reference, the resistivity is shown as "10^{-8} Ωm", but there is the number of digits, 1×10^{21}, in the "resistivity of SiO_2" column of the table. Therefore, the resistivity of SiO_2 is a value obtained by multiplying 10^{-8} Ωm

by 1×10^{21}, i.e., 10^{13} Ωm. Thus, the resistivity shown in the Declaration submitted with the response agrees with that shown in the attached reference.

In light of the above, applicants respectfully submit that it is clear error to maintain a rejection on the basis that "silica" is not generally known and understood to be an insulator, (i.e. non-conductive). That is, it is obvious that the term "silica" is generally used for silicon dioxide being electrically non-conductive and that all silica is non-conductive unless some other material having conductivity, such as a metal, is included therein. As such, a recitation of "silica" as non-conductive within the claim language is merely a recitation of a known physical property and adding this language to the claim is not new matter under 35 U.S.C. §112, 1st paragraph.

Wherefore, applicants respectfully submit that this application is now in condition for allowance, and respectfully request that the rejection under 35 U.S.C. §112, 1st paragraph be withdrawn.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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